

REMARKS

No claims have been amended or cancelled pursuant to the present reply. Thus, claims 1-8 are pending in the present application.

Examiner Interview

The Applicants' wish to thank Examiner White for the courtesy of granting a telephone interview with the Applicants' undersigned representative on March 17, 2004. Per Examiner White's request, the Applicants are submitting this reply which repeats the Applicants' remarks as set forth in that interview. The Applicants respectfully submit that claims 1-8 are patentable over the cited references in view of these remarks.

Claim Rejections—35 U.S.C. § 103 (Heidel & Bruzzese)

Claims 1-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,342,047 to Heidel et al. in view of EP 0 789 338 to Bruzzese. The Applicants respectfully traverse these rejections for at least the following reasons.

Claim 1, the sole independent claim in the present application, requires, *inter alia*:
a unitary touch screen overlapping both said video portion and said non-video portion, said video portion including player-selectable first indicia selectable via said unitary touch screen and said non-video portion including permanent player-selectable second indicia selectable via said unitary touch screen.

Put simply, a single touch screen covers the video and non-video portions of a display of a gaming machine. The cited references, alone or in combination, do not teach, suggest, or disclose a gaming machine having a touch screen that covers the video and non-video portions of the display.

The Applicants respectfully submit that the office action appears to mischaracterize the cited references and cites a motivation for combining the references that simply does not exist. Regarding Heidel—the primary reference—the office action states “Heidel teaches . . . the non-video portion including permanent player selectable second indicia selectable via the touch screen (abstract; Fig. 1).” Office Action, Dec. 16, 2003, at page 2. The Applicants respectfully submit that this statement mischaracterizes Heidel; Heidel only discloses that various indicia (e.g., cards 16a-16d; hold indicators 20a-c; and machine control indicators including a collect indicator 22, a bet one indicator, a bet max indicator, a deal/rebet indicator 29, and a menu indicator 24a) are displayed on the touch screen 12. Heidel at col. 2, lines 22-44 (emphasis added) and FIG. 1. Heidel does not teach, suggest, or disclose that these displayed items are

permanent as required by the Applicants' claim 1. It appear that Heidel discloses just the opposite—the various indicia are not permanent—as Heidel discloses several alternative embodiments of the display in FIGS. 1-2d, none of which include the same indicia.

The Office Action goes on to state that “. . . Heidel lacks disclosing a touch screen overlapping the non-video portion of the machine.” The Office Action then seeks to combine Heidel with Bruzzese to make up for this deficiency of Heidel:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the touch screen technology of Bruzzese over the non-video {electromechanical buttons} of Heidel in order to make the buttons easier to operate by making them touch sensitive. **This would allow for quicker input by the players.**

Office Action, Dec. 16, 2003, at pages 2-3 (emphasis added). The motivation cited in the Office Action for combining references and modifying Heidel to remove the electromechanical buttons—making operation easier and accelerating the game play—stands in stark contrast to the disclosure and teachings of Heidel, the primary reference. Heidel specifically states that the electromechanical game control buttons 32a-e allow for faster game play. *See, e.g.*, Heidel at col. 2, lines 53-56; *See also*, Heidel at col. 1, lines 34-44 (touch screen slows game play). Heidel further states, “. . . the experienced player can play the poker game faster by using the [electromechanical] buttons 32a-e which will tend to increase his enjoyment of the game while as the same time increase the potential earning of the machine.” Heidel at col. 3, lines 35-39. It is clear from the Heidel reference that the touch screen does not ease operation in a manner that allows for quicker input by the players as alleged in the office action. Thus, the alleged motivation for combining and modifying the cited references simply does not exist.

A *prime facie* case of obviousness requires, *inter alia*, some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify reference teachings or to combine reference teachings. MPEP § 2143.01. The Office Action fails to set forth a *prime facie* case of obviousness because the stated motivation for combining the cited references does not exist. Not only does the alleged motivation for combining the references not exist, the primary reference teaches away from the claimed invention—Heidel teaches that physical/electromechanical game control buttons should be used to speed game play. The law of obviousness requires that a reference be considered as a whole, including those portions that teach away from the Applicant's claimed invention. *See W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.3d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983)

("[T]he totality of a reference's teaching must be considered."); *see also* M.P.E.P. § 2141.02 (stating that prior art must be considered in its entirety including disclosures that teach away from the claims).

Thus, the Applicants respectfully submit that claim 1, and the claims that depend therefrom, are patentable over Heidel in view of Bruzzese under 35 U.S.C. § 103(a) for at least the foregoing reasons.

Turning now to the rejection of claim 3, which depends from claim 1, claim 3 requires that "said non-video portion includes an artwork panel," wherein the non-video portion is overlapped by a touch screen. (An example of the gaming machine having an artwork panel overlapped by a touch screen is shown in FIG. 1 and discussed at page 5, lines 5-8, of the Applicants' specification.) The combination of the cited reference does not teach, suggest, or disclose a gaming machine having an artwork panel overlapped by a touch screen. Rather, Bruzzese merely shows a plant design on the gaming machine cabinet in its FIG. 1; both references disclose a touch screen. However, there is no teaching, suggestion, or disclosure in the cited references that a touch screen overlaps an artwork panel. The mere fact that the touch screen of Heidel or Bruzzese could overlap the plane design on the Bruzzese gaming-machine cabinet does not create a *prime facie* case of obviousness because nothing in the cited references suggests the desirability of doing so. *See* M.P.E.P. § 2143.01 ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination"); *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

Thus, the Applicants respectfully submit that claims 3, and the claims that depend therefrom, are patentable over Heidel in view of Bruzzese under 35 U.S.C. § 103(a) for at least this reason as well.

Conclusion

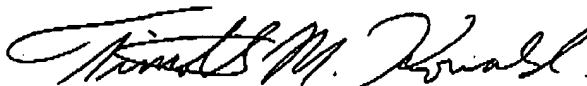
In conclusion, the Applicants respectfully submit in view of the remarks set forth herein that all rejections have been overcome and that all claims are in condition for allowance, and such action is earnestly solicited.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number indicated.

The Applicants respectfully submit that no fee is due in connection with the present Reply. The Applicants' are submitting a Petition For Extension Of Time Under 37 C.F.R. § 1.136(a) and the corresponding fee. The Commissioner is authorized to charge any required fees while this application is pending (except the issue fee) to Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447(47079-00086USPT).

Respectfully submitted,

Date: March 18, 2003



Timothy M. Kowalski
Reg. No. 44,192
JENKENS & GILCHRIST, P.C.
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-8518
(312) 425-3909 (fax)
tkowalski@jenkens.com

ATTORNEYS FOR APPLICANTS